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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN SCHMID,
JOHN L. STOFFEL, and
BILL SPERRY

Appeal 2009-006749
Application 10/696,344
Technology Center 1700

Before MICHAEL P. COLAIANNI, CHUNG K. PAK, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is a decision on an appeal under 35 U.S.C. § 134 from the
Examiner's final rejection of claims 1 through 32, which are all of the claims

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 6.

We REVERSE.

STATEMENT OF THE CASE

The subject matter on appeal is directed to, *inter alia*, a highlighter ink composition.

The Examiner maintains the following rejections:

- 1) Claims 1, 2, 4-7, 9-12, 27, and 28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Pentel^{2,3} (JP 63-61065, published Mar. 17, 1988) and Mammen (US 2003/0226474 A1, published Dec. 11, 2003);
- 2) Claims 3 and 8 are rejected under 35 U.S.C. § 103(a) as unpatentable over Pentel and Mammen, and further in view of Kaufmann (US 5,279,652; issued Jan. 18, 1994);

² It appears from the Answer that the Examiner relies on the abstract as prior art conforming to JP 63-61065 to support the rejection. Appellants do not dispute that this abstract is available prior art. Indeed, the abstract discloses that its copyright date is 1988. Accordingly, we decide this case based on the abstract, which conforms to JP 63-61065, and the other applied prior art references.

³ Appellants argue (App. Br. 18 and 19) that the Examiner is required to provide a full translation of JP 63-61065. However, the appropriate avenue for redress is by way of a petition (37 C.F.R. § 1.181) requesting, *inter alia*, that a full translation be obtained and supplied by the Examiner and not by way of an appeal to the Board. *See, e.g. Manual of Patent Examination Procedure* (MPEP) § 706.02(II) (8th ed., Rev. 6, September 2007).

- 3) Claims 13-18, 29, and 30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mammen, Pentel, and Kaufmann; and
- 4) Claims 19-26, 31, and 32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mammen, Pentel, and Kaufmann.

REJECTION (1)

ISSUE

Did the Examiner err in determining that it would have been obvious to combine Pentel and Mammen to arrive at the invention recited in claim 1 within the meaning of § 103? We decide this issue in the affirmative.

FINDINGS OF FACT

1. The Specification discloses that "[s]uitable acid buffers can include . . . ascorbic acid." (Spec. 5, II. 27-30). The Spec. states that an "acid buffer" refers to a chemical compound in a composition which act to maintain the pH in a desired acidic range." (Spec. 3, II. 17-19).
2. Pentel teaches that

The aimed [sic] ink composition consisting of (A) preferably 2~17 wt% coloring material (e.g. dye, pigment, etc.), (B) preferably 65~85wt% organic solvent (e.g. ethanol, methyl ethyl ketone, ethyl acetate, benzene, Cellosolve, etc.) and (C) preferably 0.5~3wt% compound (e.g. ascorbic acid, dipalmitate of ascorbic acid, magnesium salt of ascorbic acid phosphoric ester, etc.).

(Pentel, Abstract).

3. Pentel does not disclose the function of its ascorbic acid.
4. Mammen teaches a smear-resistant ink composition having, *inter alia*, a fluorescent dye, which may be used in highlighters. (Mammen, ¶¶

[0004] and [0115]). Mammen teaches the use of a basic color stabilizer "to adjust the pH and keep the pH in a relatively alkaline range in order to ensure that the dyes used retain their color." (Mammen, ¶ [0102]). Mammen teaches that "[t]he ink composition can further contain a resin that is soluble in an aqueous alkaline medium" (Mammen, ¶ [0103]).

Additional findings of fact may appear in the Analysis that follows.

PRINCIPLES OF LAW

"[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS AND CONCLUSION

The Examiner states that it would have been obvious to add Mammen's fluorescent dye (highlighter colorant that is a fluorescent colorant), which may be used in highlighters, to Pentel's composition in order to "have a smear resistance highlighter ink composition." (Ans. 4).

Appellants argue that the combination of Pentel and Mammen is improper. (App. Br. 16). Specifically, Appellants argue that Mammen cannot be combined with Pentel's *acid*-containing ink composition since

Mammen teaches that the pH may be adjusted in an *alkaline* range so as to stabilize the color. *Id.* We agree with Appellants.

Pentel teaches using ascorbic acid in its general colorant ink composition. (FF 2). Pentel, however, does not teach a highlighter colorant that is an acid-functionalized pigment or a fluorescent colorant as required by claim 1.

Mammen teaches an ink composition that may have, *inter alia*, a fluorescent dye (highlighter colorant that is a fluorescent colorant) and a color stabilizer to keep the pH in an alkaline (i.e., basic) range "in order to ensure that the dyes used retain their color." (FF 4).

Thus, even though Pentel does not disclose (FF 3) the function of its ascorbic acid, if we presume *arguendo* that the Examiner is correct in finding that Pentel's ascorbic acid is capable of functioning as an acid buffer (i.e., maintain the pH in a desired acidic range), it is unclear to us *why* one of ordinary skill would add Mammen's fluorescent dye (highlighter colorant that is a fluorescent colorant), which uses an alkaline (i.e., basic) solution for color stability, in Pentel's general colorant ink composition having, *inter alia*, ascorbic acid.

Thus, it follows that the Examiner erred in determining that it would have been obvious to combine Pentel and Mammen to arrive at the invention recited in claim 1 within the meaning of § 103.

Accordingly, we reverse the Examiner's decision to reject claims 1, 2, 4-7, 9-12, 27, and 28 under 35 U.S.C. § 103(a) as unpatentable over Pentel and Mammen.

REJECTIONS (2) through (4)

The Examiner relies on a similar rationale discussed above to combine Pentel and Mammen to meet the same or the similar features required by the rejected claims. In addition, the Examiner does not articulate any reason to combine the other applied prior art reference (i.e., Kaufmann) with Pentel or Mammen to arrive at the claimed inventions.

Therefore, for the reasons stated above, we reverse the Examiner's decision to reject the claims stated in rejections (2) through (4).

ORDER

In summary, we reverse the Examiner's decision to reject the claims stated in rejections (1) through (4).

Accordingly, the Examiner's decision is reversed.

REVERSED

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HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMIN.
3404 E. HARMONY ROAD
MAIL STOP 35
FORT COLLINS, CO 80528